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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,957	09/22/2003	David Goldberg	D/97420C XERZ 2 001 15-1	1211
7590	11/17/2004		EXAMINER WALLERSON, MARK E	
Patrick R. Roche FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP SEVENTH FLOOR 1100 SUPERIOR AVENUE CLEVELAND, OH 44114-2579			ART UNIT 2626	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,957	<b>Applicant(s)</b> GOLDBERG ET AL.	
	<b>Examiner</b> Mark E. Wallerson	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/03, 9/22/03</u> . | 6) <input type="checkbox"/> Other: ____  |

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**Part III DETAILED ACTION**

**Notice to Applicant(s)**

1. This application has been examined. Claims 1-17 are pending.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Cooper et al (Cooper) (U.S. 5,465,167).

With respect to **claims 1, 6, 7, 8, 11, 12, and 13** Cooper discloses means for automatic creation of a form comprising a printer (84, figure 3); a print server for controlling system operations (which reads on fax server) (column 1, lines 39-42); means for identifying a document white area of a printing job and a user of the printer (which reads on identifying a segment of a field of a form in which the user has marked, wherein the form may include a cover note field , and when the cover note field is marked, the machine may include an image of the cover note field in an automatically created cover sheet) (22, figure 1, column 1, lines 56-60, column 6, lines 26-28, and column 7, lines 5-9); means for storing a profile by subject of information desired by the user (which reads on an information database that includes a list of distribution lists and a list of documents and forms, and the user can set up new distribution lists and categories) (column 8, line 61 to column 9, line 9); means for linking the server to the source

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of information (which reads on the server giving database instructions) (column 8, lines 48-55 and column 1, lines 39-42), and a printer (84) for printing the selected information in the document white space (column 7, lines 16-29).

With respect to **claim 2**, Cooper discloses memory means for storing a group of information from which desired information is stored (which reads on a database that includes categories of documents that the user may select from) (column 8, line 61 to column 9, line 9).

With regard to **claims 3 and 10**, Cooper discloses a harvester (calling means) to allow the server to collect information from the database (column 8, lines 48-45).

With respect to **claim 4**, Cooper discloses that the server is networked to plural users (column 8, line 67 to column 9, line 3).

With respect to **claims 5 and 9**, Cooper discloses an editor (column 6, lines 54-60).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14, 15, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (Cooper) (U.S. 5,465,167) in view of Ferrel et al (Ferrel) (U.S. 5,860,073).

With respect to **claim 14**, Cooper discloses generating the pre-selected document (which reads on the form) (10, figure 1) and storing a profile by subject of information desired by the

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user (which reads on an information database that includes a list of distribution lists and a list of documents and forms, and the user can set up new distribution lists and categories) (column 8, line 61 to column 9, line 9), and selecting means (a pointer) for selecting items of interest from the data stream (which reads on selecting files in which data defining the document are stored) (column 9, lines 5-9).

Cooper differs from claim 14 in that he does not clearly disclose selecting particular portions of the items of interest from a data stream, wherein the portions are dynamic.

Ferrel discloses selecting particular portions of the items of interest from a data stream (which reads on selecting world; national; health & fitness, or local subsets (412, figure 7) of the news data stream (410, figure 7), wherein the portions are generated by another (which reads on the information being provided by a publisher) (column 6, lines 64-67) and are dynamic (which reads on the information or content to be synthesized onto the page is updated continually) (column 9, lines 20-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper wherein particular portions of the items of interest from a data stream would be selected, and the portions are generated by another and are dynamic. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper by the teaching of Ferrel in order to give the user more personalized information to enjoy as disclosed by Ferrel in column 3, lines 25-27.

With respect to **claim 15**, Cooper discloses a printer (84) for recording the form, and means for deleting segments of data stored in the database (which reads on avoiding printed items of interest for avoiding repetition) (column 16, lines 40-46).

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With respect to **claims 16 and 17**, Cooper differs from claims 16 and 17 in that he does not clearly disclose that the data stream is harvested from a website. Ferrel discloses a publishing system in which text or graphics are merged into a display region of a page (the abstract, lines 2-9), wherein browsers (which reads on a harvester) are used to tag text into the documents (column 2, lines 5-17). Additionally, Ferrel discloses gathering (harvesting) the linked content onto the page (column 6, lines 64-66). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper wherein the browser would have been used to harvest data from a website. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Cooper by the teachings of Ferrel in order to allow personalization of the page by allowing the user to insert various information such as stock quotations as taught by Ferrel in column 3, lines 25-27 and column 8, lines 12-21.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626

MARK WALLERSON  
PRIMARY EXAMINER

